

Appl. No. 10/676,662  
Response dated March 1, 2006

### **REMARKS**

Claims 1, 4, 7-9, 11, 14, 15, 17-19, 21, and 24-34 are currently pending in this continuation application. Reconsideration of the claims of this continuation application in view of the following remarks is respectfully requested.

#### **A. Rejection Of Claims 1, 4, 7, 9, 11, 14, 15, 18, 19, 21, 24, 25, 27-29, 31, and 34 Under 35 U.S.C. § 103(a)**

Claims 1, 4, 7, 9, 11, 14, 15, 18, 19, 21, 24, 25, 27-29, 31, and 34 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 5,846,262 issued December 8, 1998 to Sayama et al. ("Sayama") in view of U.S. Statutory Invention Registration H1674 published August 5, 1997 to Ames et al. ("Ames"). Applicants traverse the rejection, and respectfully assert that the Examiner has again failed to give proper weight to the exclusionary phrase "consisting essentially of" in construing the claims.

The Examiner correctly points out that "[a]lthough the claims are interpreted in light of the specification, limitations from the specification are not read into the claims." It is true that claims are not to be read narrowly to include only the exemplary embodiments disclosed in the specification. However, when the applicant explicitly states the meaning that the claim terms are intended to have, the claims are examined with that meaning, in order to achieve a complete exploration of the applicant's invention and its relation to the prior art. In re Zletz, 13 USPQ 2d 1320, 1322 (Fed. Cir. 1989) (emphasis added). MPEP section 2173.05(a) states:

***When the specification states the meaning that a term in the claim is intended to have, the claim is examined using that meaning...*** (emphasis added; citations omitted).

The section continues and states that "[i]f the claims, read in light of the specification, reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the statute (35 U.S.C. 112, second paragraph) demands no more." Applicants submit that the phrase "consisting essentially of an elastic nonwoven material" is adequately defined so that one skilled in the art of absorbent articles would be reasonably apprised of the scope and utilization of the invention based on the claims, in view of the specification. Therefore, the claims must be examined using the definition recited in the specification.

Each of the currently pending independent claims (claims 1, 9, and 19) requires that each attachment panel consist essentially of an elastomeric nonwoven material, each of which defines an inner attachment surface. It is widely accepted that the transitional phrase "consisting essentially of"

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limits the scope of a claim to the specified materials "and those that do not materially affect the basic and novel characterisitic(s)" of the claimed invention. MPEP 2111.03, citing *In re Herz*, 537 F.2d 549, 551-52 (CCPA 1976) (emphasis in original). Applicants have clearly indicated in the specification what the basic and novel characteristics of the claimed invention are with respect to this claim phrase: "In particular embodiments, the attachment panels consist essentially of the elastomeric nonwoven materials such that no separate fastening materials or fastening elements, loop material for example, are formed from or attached to the attachment panels." Applicants' specification, page 3, lines 18-21 (emphasis added). Each of the independent claims further sets forth that the inner attachment surfaces directly engage fastening elements present on an opposite waist region.

Sayama discloses a diaper 1 provided with front wings 11 and rear wings 12. Col. 2, lines 4-7. The diaper is provided with a hooked fastener component 15 bonded to the inner surface of each rear wing, which interlocks with a looped fastener component 16 bonded to the outer surface of the front waist region and wing 6,11. Col. 2, lines 19-42. Since each wing of the Sayama diaper has a fastener bonded thereto, none of the wings can "consist essentially of an elastomeric nonwoven material." Consequently, Applicants' invention as presently claimed is patentable over Sayama/Ames.

In summary, the Examiner cannot abide by MPEP 2173.05(a) – which requires that "*when the specification states the meaning that a term in the claim is intended to have, the claim is examined using that meaning*" - by ignoring a definition in the specification.

Applicants explicitly reserve the right to identify additional errors in the Office Action and advance further reasons for patentability should the present response not result in withdrawal of the rejection.

#### **B. Rejection Of Claims 8, 17, 26, and 30 Under 35 U.S.C. § 103(a)**

Claims 8, 17, 26, and 30 stand rejected as being unpatentable over Sayama and Ames and further in view of U.S. Patent 5,087,253 issued February 11, 1992 to Cooper. Applicants respectfully traverse the rejection for at least the reasons noted above in regard to the rejection of independent claims 1, 9, and 19. Accordingly, this rejection should be withdrawn. Applicants explicitly reserve the right to identify additional errors in the Office Action and advance further reasons for patentability should the present response not result in withdrawal of the rejection.

#### **C. Double Patenting**

Claims 1, 4, 7-9, 11, 14, 15, 17-19, 21, and 24-34 stand rejected under the judicially created doctrine of obviousness-type double patenting as being obvious over claims of U.S. Patent No. 6,645,190. Applicants have enclosed herewith a terminal disclaimer in compliance with 37 C.F.R. §§

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1.321(b) and (c) in order to expedite prosecution of the present application. It is respectfully submitted that the terminal disclaimer overcomes the obviousness-type double patenting rejection.

For the record, Applicants note that they have chosen not to address the merits of the Examiner's conclusions concerning the obviousness-type double patent rejection, but have instead elected to file a terminal disclaimer to expedite grant of the present application, particularly in view of the fact that there should be no adverse impact on the term of the resulting patent.

**D. Conclusion**

The application now contains claims 1, 4, 7-9, 11, 14, 15, 17-19, 21, and 24-34 which are believed to be in condition for allowance in view of the foregoing remarks.

Please charge any prosecutorial fees which are due to Kimberly-Clark Worldwide, Inc. deposit account number 11-0875.

The undersigned may be reached at: (920) 721-7844.

Respectfully submitted,

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**CERTIFICATE OF TRANSMISSION**

I, Mary L. Roberts, hereby certify that on March 1, 2006 this document is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (571) 273-8300.

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